

Serial No.: 10/065,283
Attorney Docket No.: F-523

Patent
RECEIVED
CENTRAL FAX CENTER
JAN 06 2005

REMARKS

1. Status of Claims

Claims 1-8 were pending in the Application. Applicants have amended claims 1, 3 and 7 without prejudice or disclaimer and added new claims 9-20. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-20 will remain pending in the application.

2. Objections to Specification

In section 1 of the Office Action, the Examiner objected to a section heading that is automatically inserted by the USPTO electronic filing system. Nevertheless, Applicants have amended the specification to remove the heading and request that the objection be withdrawn.

The Examiner objected to the Abstract and a replacement is provided. Accordingly, Applicants respectfully request that the objection be withdrawn.

3. Objections to Claims

In section 2 of the Office Action, the Examiner objected to claim 7 for a noted informality. Applicants have amended claims 3 and 7 for purely cosmetic reasons and respectfully request that the objection be withdrawn.

4. Rejections under 35 USC § 103(a)

In section 4 of the Office Action, the Examiner rejected Claims 1-2 and 5-8 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application No. 2002/0006212 submitted by Rhoads, et al. ("Rhoads '212") in view of U.S. Patent No. 6,666,376 B1 to Ericson ("Ericson '367").

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended claim 1.

Serial No.: 10/065,283
Attorney Docket No.: F-523

Patent

In contrast to the assertion by the Examiner, Rhoads '212 does not describe identifying a version of a form, but merely discusses embedding a unique document identifier that may include document version information. Similarly, the cited reference describes a database of document revision numbers in which each document has a unique identifier. Such a system does not teach or fairly suggest a form version database.

Applicants also respectfully disagree with the Examiners apparent Official Notice that it is common to update remote databases as applied. For example, Rhoads '212 does not describe or suggest a distributed database such as currently claimed.

Applicants respectfully submit that the references are not properly combined. Rhoads '212 does not contemplate a pointing instrument at all and certainly does not contemplate forms that may be filled in using a pointing instrument such as a digital pen.

Amended claim 1 recites:

processing pointing instrument input data obtained using the form if the form is an acceptable version.

Rhoads '212 does not teach or suggest such a fillable form.

Regarding claim 7, Applicants respectfully submit that all claim terms must be considered in determining patentability.

Regarding claim 8, Rhoads '212 does not even contemplate a pointing device or a fillable form version database.

In section 5 of the Office Action, the Examiner rejected Claims 3-4 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Published Patent Application No. 2002/0006212 submitted by Rhoads, et al. ("Rhoads '212") in view of U.S. Patent No. 6,666,376 B1 to Ericson ("Ericson '367") and in further view of U.S. Published Patent Application No. 2002/0169963 submitted by Seder, et al. ("Seder '963").

Serial No.: 10/065,283
Attorney Docket No.: F-523

Patent

Applicants respectfully traverse the rejection. However, solely in order to expedite prosecution, Applicants have amended claim 1.

Applicants respectfully submit that claims 3-4 are patentable over the cited references for at least the reasons described above.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1-8.

Applicants have added new claims 9-20 and submit that the new claims are patentable over the cited references.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-20 is patentable and in condition for allowance.

5. Conclusion Of Remarks

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

6. Authorization

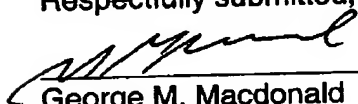
No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-523.

Serial No.: 10/065,283
Attorney Docket No.: F-523

Patent

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-523.

Respectfully submitted,


George M. Macdonald
Reg. No. 39,284
Attorney of Record
Telephone (203) 924-3180

PITNEY BOWES INC.
Intellectual Property and Technology Law Department
35 Waterview Drive, P.O. Box 3000
Shelton, CT 06484-8000